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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/066,168 04/24/98 KATSUBE

M 10089/4

IM22/0327

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NEW YORK NY 10004

EXAMINER

FORTUNA, A

ART UNIT

PAPER NUMBER

1723

DATE MAILED:

03/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/066,168

Applicant(s)
Katsube et al.

Examiner
Ana Fortuna

Group Art Unit
1723

☒ Responsive to communication(s) filed on Feb 29, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 2 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 2 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93.07958 in view of Sekino et al. and Ethiene et al. This rejection was discussed in paper No. 4.

Response to applicant's remarks: The rejection above was discussed in the prior Office action, paper No. 4. Claim 1 as amended has been also included now in the rejection. Sekino et al. discloses the retentate outlet in communication with the gap and the outside of the container wall, and fails to disclose the location as opposed to the outer surface of each element. Location of the retentate outlet at the end of the container and opposed to the fiber bundle and extending through the container, for removing retentate from the gap between the fibers and the container wall is conventional in the art, therefore, it would have been obvious to one skilled in the pertinent art to move the outlet (7, 9) of Sekino et al to any other position with respect to the housing wall, for the same purpose of removing retentate from the gap. Reference 5,814,179 show the state of the art (note retentate exit 6 b). Regarding to the amendment to the claims and the Declaration filed on 1/3/2000, the results shown in the declaration appear to be true for the for the particular selected pressure vessel length, but not applicable to any length of pressure vessel for the filter, since for vessel for example having 1394 mm the outlet will change in position with respect to the housing length, therefore affecting the degree of deposition of the scale at levels different from the ones

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shown in the decalration. If $d = 0.6$ m for a length of about $\frac{1}{2}$ of the housing lenthth selected in the declaration the outlet possition will be approximately located about $\frac{1}{2}$ of the housing length, which will affect the scale and salt rejection of the membrane in the housing. The rejection is maintained because although the outlet location at a specific distance from the end of the housing is not disclosed by the prior art of record, in order to consider the location of the outlet critical it woul need to be relative to the housing length or size.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857.

Facsimile No. (703)305-7718.

Ana Fortuna

March 24, 2000


ANA FORTUNA
PRIMARY EXAMINER
GROUP 1300
1723